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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,961	10/30/2000	Darshatkumar Shah	MS150612.1	8291

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,961

Applicant(s)

SHAH, DARSHATKUMAR

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,18-20,22,31,33,35,43,44,46,47,49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Currently amended claims subject to restriction and/or election requirement are 1,3-5,7,18-20,22,31,33,35,43,44,46,47,49 and 50.

DETAILED ACTION

Response to Amendment

1. Amendment received on 6/30/2006 is acknowledged. The applicant has amended claims 1, 3, 7, 18-19, 22, 31, 33, 35, 44, and 50 and canceled claims 5 and 34. Currently claims 1, 3-5, 7, 18-20, 22, 31, 33, 35, 43-44, 46-47 and 49-50 are pending for examination.

The reply filed on 6/30/2006 is not fully responsive to the prior Office Action because newly submitted amended independent claims 1, 18, 31 and 33 and their dependencies 3-4, 7, 19-20, 22, 35, 43-44, 46-47, and 49-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly submitted and amended independent claims 1, 18, 31 and 33 recite new limitations, that is ***comprising a wish list component that allows one or more merchant servers to access a wish list on the user's computer and that allows the one or more merchant servers to place one or more items corresponding to the wish list into the shopping basket component*** (see currently amended independent claims , 1, 18, 31 and 33) have a different and distinct utility than the earlier claimed invention. The different and distinct utility is using a programmable shopping basket such that any application program with permission may access the wish list/user's list and add items to the user's shopping basket list if a match exists between the added item and an item in the list (see applicant's disclosure, page 2, line 18-page 3, line 4,

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Fig.8 and page 9, line 21-page 10, line 7 which describe and disclose this embodiment different and distinct from the earlier embodiment [see applicant's disclosure page 2, lines 1-17, Figs 2a, 2b, 3b, Figs 4-7 and page 8, line 24-page 9, line 20 to which the earlier filed claims in this application were directed])which was not required by the earlier filed invention/claims.

The applicant has already elected an invention, that is originally filed claims examined in the earlier office actions directed to a system facilitating electronic shopping comprising a graphical image component residing on a user interface, such as a web browser, a search engine component, a shopping basket component and an ordering component enabling the users to access the one or more merchants' web sites to select, drag and drop selected items in the shopping basket component and to place order for them concurrently (see earlier filed independent claims 1, 18, 31 and 33) and is different and distinct from the currently amended claims filed on 6/30/2006 for reasons given above. Therefore the newly submitted amended claims 1, 3-5, 7, 18-20, 22, 31, 33, 35, 43-44, 46-47 and 49-50 are distinct and divergent from the earlier claimed inventions and would require a new, divergent and different search. Such change in the inventions amount to a " Shift claiming another invention after an election is once made and action given on the elected subject matter and are therefore subject to " Election by Original Presentation", as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

819 Office Generally Does Not Permit Shift:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given

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on the elected subject matter. **Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right).** When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

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821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, **MPEP § 818.01**

37 CFR 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143**

¶ 8.04 Election by Original Presentation.....

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An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, currently amended

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claims 1, 3-5, 7, 18-20, 22, 31, 33, 35, 43-44, 46-47 and 49-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The amendment filed on 6/30/2006 presenting only claims drawn to a non-elected invention is ***non-responsive*** (MPEP § 821.03). The currently amended claims 1, 3-5, 7, 18-20, 22, 31, 33, 35, 43-44, 46-47 and 49-50 are not readable on the elected invention because they are subject to "Election by Original Presentation", as analyzed above. Since all the currently amended claims are drawn to the non-elected invention, the amendment is not entered.

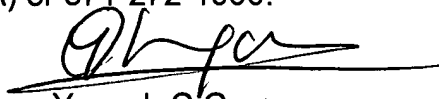
4. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
9/6/2006